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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/211,942	12/15/1998	JIM A. LARSON	884.078US1	9145

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EXAMINER

OSORIO, RICARDO

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/211,942

Applicant(s)

LARSON ET AL.

Examiner

RICARDO L. OSORIO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/09/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-16,20,21 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-16,20,21 and 23-37 is/are rejected. /
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 4/9/06
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 8-16, and 20-21, drawn to a stylus comprising a microphone, classified in class 345, subclass 179.
 - II. Claims 23-27, voice communication between a PDA and a PC, classified in class 704, subclass 200.
2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in-scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as a stylus comprising a microphone, which does not require voice communication between a PDA and a PC, as recited in subcombination II. See MPEP § 806.05(d).
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Walter Nielsen on April 11, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 8-16, and 20-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-14, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyoshi Horie (JP 06131108 A (translation provided), hereafter referred to as Horie) in view of Stevens III (5,769,643).

Regarding claims 8-14, and 16, Horie teaches of a system comprising a stylus (Fig. 1, reference character 1) comprising; a microphone to detect and to output electronic voice signals (Fig. 1, reference character 1a); and a transmitter located in the housing to transmit the electronic voice signals from the microphone to a personal computer (reference character 1c); the personal computer having a processor (reference characters 5 and 6), speech recognition software to instruct the processor to translate the electronic voice signals into translated voice data (reference character 19, and see translation, page 3, lines paragraphs 24-26), and a wireless transmitter to transmit the translated voice data (reference character 4); the computer (same as PDA) having a touch screen display

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(reference characters 2 and 17) to enter information in response to physical contact (see translation, page 3, paragraphs 29-31), and to display the translated voice data (see translation, page 4, paragraphs 42-47); the stylus and the computer (same as PDA) are electrically coupled using at least one wire (see translation, page 1, paragraph 6, line 2).

However, Horie does not precisely teach of the PDA comprising a wireless receiver to receive the transmitted voice data from the personal computer, the computer and the PDA having bidirectional communication, and storing the translated voice data in the PDA.

Stevens clearly teaches of a PDA system comprising: a wireless transmitter to transmit electronic voice signals to a PC (see, figs.3 (64,63) and 4; col.3, lines 8-19, lines 35-39); a wireless receiver to receive voice from the PC (see, fig.3 (64,67), col.3, lines 20-22); a touch screen display to enter information in response to physical contact and to visually display the translated voice information (fig.4 (54,56)); col.3, lines 8-22); a stylus having a first end to provide physical contact with the touch screen (fig.4 (55)); a memory for storing voice data transmitted from the PC (fig. 3 (58,60; col. 3, lines 20-22)). **Stevens** also teaches that the PC having a processor (fig.3 (42)); a wireless receiver and transmitter (fig.3 (30)) voice data and the stylus communicating with the PDA (fig.3 (55,62); fig.4 (55,12)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have bidirectional voice data communication between a PDA and a PC, as taught by Stevens, in the device of Horie because it is well known in the art of computer communications that two computers, including a PC and a PDA are capable of

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bidirectional voice data communications, just as different other types of data are shared between a PC and a PDA for the purpose of communication and convenience.

Regarding claim 20, Horie teaches that the microphone is located at a second end of the stylus (reference character 1a. The first end is the stylus tip).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horie and Stevens III as applied to claim 12 above, and further in view of Wakisaka et al. (6,112,174).

Regarding claim 15, further, Horie, as anticipated by Stevens, does not specifically teach of translation of the electronic voice signals being performed in the PDA.

Wakisaka teaches of a PDA that receives electronic voice signals from a microphone (Fig. 4, reference character 101) and translates the electronic voice signals (Fig. 4, reference characters 106,107, and col. 7, lines 31-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the PDA, as taught by Wakisaka, in the combined device of Horie and Stevens because it is well known in the art of PDAs to have the capability of speech recognition (col. 1, lines 16-19) since the PDAs have the convenience of being easily transported and stored.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horie and Stevens III as applied to claim 8 above, and further in view of Ohashi (5,581,783).

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Regarding claim 21, further, the device of Horie, as anticipated by Stevens, does not specifically teach of a switch circuit to activate and deactivate the microphone and the transmitter of the stylus.

Ohashi teaches of a switch circuit to activate and deactivate the microphone and the transmitter of the stylus (col. 6, line 63-col. 7, line 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the switch of Ohashi, in the combined device of Horie and Stevens so that the user can have the option of using either the writing option or the voice option for convenience and to avoid accidental activation or transmission from either the microphone or the writing/selecting tip.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is 571-272-7676. The examiner can normally be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala whose telephone number is 571-272-7681.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

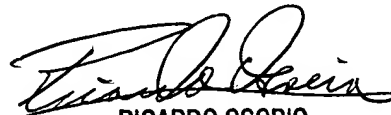
or faxed to: 571-273-8300 (for Technology Center 2600 only)

Hand-delivered responses should be brought to the Customer Service Window at the Randolph Building, 401, Dulany Street, Alexandria, VA 22314.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RICARDO OSORIO
PRIMARY EXAMINER
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RLO
May 17, 2006